

## **REMARKS**

### ***Substitute Amendment***

This Amendment Under 37 C.F.R. § 1.111 is a substitute for an Amendment Under 35 U.S.C. § 114(c) that was filed on March 26, 2009, and was fully responsive to the Office Action mailed October 6, 2008. The Amendment as filed was accompanied by a request for an RCE, However, the Office Action dated October 6, 2008 was a first Office Action after filing an RCE by previous counsel on September 3, 2009. Prosecution was not closed. Pursuant to the provisions of MPEP 706.07(h), the filing of an RCE and Amendment under 37 CFR § 114 is improper since “An applicant cannot request continued examination of an application until after prosecution in the application is closed. See 37 CFR 1.114(a).”

Accordingly, the Commissioner for Patents is respectfully requested either (1) to treat the previously filed Amendment as a submission under 37 C.F.R. § 1.111 and ignore the present Substitute Amendment or (2) to accept the present Amendment as a proper substitute for the previously timely filed Amendment and to amend the above-identified patent application in accordance with the arguments and amendments made herein.

The foregoing approach was discussed with and recommended by Examiner Pagan’s supervisor Mickey Yu on April 7, 2009.

### ***Summary of Claims***

Claims 1-4, all the claims pending in the application, stand rejected. Applicants have amended claim 1 and have added new claims 5-12.

### ***Claim Rejections - 35 U.S.C. § 112***

**Claims 1-4 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.** This rejection is traversed for at least the following reasons.

The Examiner notes at page 2 of the Office Action that claim 1 contains the limitations of “stiff base portions,” but notes that the specification at paragraphs [0023] and [0038] use the

phrase “shape retaining property.” The Examiner asserts that the terms do not have the same meaning and that the limitation is considered “new matter.”

Applicants have amended the claim to use the terminology found in the specification. Thus, this rejection should be withdrawn.

### ***Specification***

The Examiner objects to the specification as failing to provide proper antecedent basis for the claimed subject matter, based upon the lack of support for the term “stiff.”

On the basis of the foregoing amendment, this objection should be withdrawn.

### ***Claim Rejections - 35 U.S.C. § 103***

**Claims 1-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Terada (JP 2000-271150) in view of Koizumi (JP 2002-1022252).** This rejection is traversed for at least the following reasons.

#### **Claim 1**

As now defined in amended claim 1, with reference to the illustration in Fig. 1(A) and Fig. 2(A) solely for illustration and without limitation, the claimed “medical kit” comprises a medical instrument housing portion (2) that has a first shape with a cut-out portion (3) and a medicinal solution housing (4) having a second shape that corresponds to the cut-out portion. As is clear from the illustration in Figs. 1(A) and 2(A), the “cut-out” has no bottom portion. Thus, the medicinal solution housing (4) is removeably attachable to the medical instrument housing (2) at the cut-out portion (3) such that the medicinal solution housing (4) can be detached without a first covering material (7) from the medical instrument housing container (2). The medicinal solution housing attaches to the medical instrument housing at the cut-out portion with means for removeably attaching the base portions. Corresponding structures for these attaching means may be seen in Figs. 1(B) and 2(B).

#### **Terada**

The Examiner looks to Terada for a structure that includes a single base 15 in a housing 11 that is shaped to have a first chamber for housing a medicinal solution and a second chamber for housing medical instruments. The two chambers are formed by deforming a single piece of material, and not two separate pieces of material, and do not have a cut-out portion, as claimed. Specifically, there is no cut-out portion in the medicinal instrument housing that is adapted to be removeably attached to the medicinal solution housing at the cut-out portion, where the medicinal solution housing has a shape corresponding to the cut-out portion. The Examiner admits this deficiency in Terada at page 4.

#### **Koizumi**

The Examiner notes that Koizumi illustrates a medicinal solution housing container 3 that is removeably attached to a medical instrument housing portion (2). However, there is no cut-out portion in Koizumi. As is clear from the illustrations in Figs. 1-22, Koizumi contemplates a base portion that has plural chambers, one or more of the chambers being adapted to receive a separate container (3, 13, 23, etc.). This structure is both wasteful of material, unnecessarily heavy and lacks the flexibility provided by the present invention whereby a removeable medicinal solution housing can be inserted into the cut-out. This permits medicinal solution containers of varying volumes to be attached, as needed.

Moreover, there is no teaching or suggestion that the chamber for receiving the container in Koizumi should have a bottom removed, as it appears the chamber having a depth equal to the depth of the medical instrument chamber is necessary for stability as a corner support of the container.

Finally, Applicant wishes to note that he has corrected certain inaccuracies in the claim as previously submitted. The claim is now structured, defines the invention clearly and accurately in such a manner that it overcomes the teachings of the prior art.

#### **Claims 2-4**

These claims would be patentable due to their dependence from claim 1.

**Claims 5 and 6**

These claims specifically state that the cut-out portion has no closed bottom and does not define a compartment.

**Claim 7**

This new claim states the invention in alternative terms based upon language taken from the specification, particularly with regard to the disclosure of the best mode for carrying out the invention beginning at paragraph [0024] of the published application.

Specifically, the medical kit is defined with regard to a “sheet body” that defines a “sheet plane” and is “concavely depressed within the sheet plane of the sheet body to form a concave portion defining at least one chamber for housing a medical instrument.” The claim further defines a cut-out portion being “an opening in the sheet body that does not define a chamber and is shaped to form a mounting portion having a first edge interlocking portion.” Support for this feature may be found at paragraphs [0023], [0026], [0029] and [0031] of the published specification. The medical solution housing is a separate body and is sized to be received in the cut-out portion, the medical solution housing having a second edge interlocking portion for engaging the first edge interlocking portion of the sheet body, as disclosed at paragraphs [0036], [0038] and [0042].

The medical instrument housing portion has a cover and the medicinal solution housing portion has a separate cover, the medicinal solution housing being detachable from the medical instrument housing portion without removing the first covering material from the medical instrument housing container.

**Claims 8-12**

These claims further define the structure of the opening that forms the cut-out portion, as disclosed at paragraph [0031]. Further, the claims describe the structures that secure the medicinal housing portion to the medical instrument housing portion, including structures that

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permit detachment vertically as well as detachment horizontally, as illustrated in Figs. 1(A) and 2(A).

On the basis of the foregoing arguments and amendments, these claims should all be patentable.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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**23373**

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